

ARGUMENTS

1.) Claim Amendments

The Applicant has amended claims 1, 3 and 23; claim 10 has been canceled. Accordingly, claims 2-9, 20-26, 29 and 30 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.) Examiner Objections – Abstract

The Examiner objected to the abstract of the disclosure because it was too long. The abstract has been amended, as previously shown, to limit the paragraph to less than 150 words. The Examiner's consideration of the amended abstract is respectfully requested.

3.) Examiner Objections - Claims

The Examiner objected to claims 3-6, because of informalities. Again, the Applicant appreciates the Examiner's thorough review of the claims. The Applicant has amended claim 3 in order to correct the informalities stated by the Examiner. Since claims 4-6 depend from amended claim 3, applicant believes the Examiner's objection has been satisfied. Examiner's consideration of the amended claims is respectfully requested.

4.) Claim Rejections – 35 USC § 112

The Examiner rejected claims 10 and 23-24 under U.S.C. 112, second paragraph for being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regard as the invention. Claim 23 recites the limitation "the distance" and was rejected for insufficient antecedent basis. Applicant has amended claim 23 to recite "a distance" in line 3. Claim 10 recites "the structures" and was rejected for insufficient antecedent basis. In order to expedite allowance of this application, the Applicant has canceled claim 10 without prejudice. Therefore, this rejection with respect to these claims is deemed to be moot.

5.) Claim Rejections – 35 USC 101

The Examiner rejected claim 10 under 35 USC 101 because claim 10 is drawn to non-statutory subject matter. In order to expedite allowance of this application, the Applicant has canceled claim 10 without prejudice. Therefore, this rejection with respect to these claims is deemed to be moot.

6.) Claim Rejections – 35 U.S.C. § 102(b)

The Examiner rejected claims 1-10, 20-24, 25, 26, 29 and 30 under 35 U.S.C. § 102(b) as being anticipated by Jammet, et al. (EP 1072228). As stated above, in order to expedite allowance of this application, the Applicant has canceled claim 10 without prejudice. Therefore, the rejection with respect to claim 10 is deemed to be moot. The Applicant has also amended claim 1 to better define the intended scope of the claimed invention.

US Patent 6,626,904 corresponds to and is believed to be representative of EP 1072228. It is respectfully submitted that a review of this patent clarifies the nature of the implant disclosed in Jammet and that Jammet fails to disclose features of the amended claim 1.

For example, amended claim 1 is directed to “a medical implant system comprising: a first bone anchor having a longitudinal axis; a second bone anchor; and a brace for coupling the first bone anchor to the second bone anchor, wherein the brace has a distal portion which is pivotally coupled to the first bone anchor and adapted to slide in a generally transverse direction in relation to the longitudinal axis of the first bone anchor.”

Jammet US patent 6,626,904 clarifies that “To this end, the element E1 comprises a block 16 secured to the lower cup 8 laterally and provided with a tapped hole 17 adapted to receive a screw-threaded rod 18 secured to the element E2.” Jammet does not disclose a medical implant system “wherein the brace has a distal portion which is pivotally coupled to the first bone anchor and adapted to slide in a generally transverse direction in relation to the longitudinal axis of the first bone anchor.”

Jammet does not disclose all of the features of amended claim 1. Therefore, it is respectfully requested that the §102 rejection of claim 1 be withdrawn.

Claims 2-9 and 20-24 depend from amended claim 1 and recite further limitations in combination with the novel elements of claim 1. Therefore, the allowance of claims 2-9 and 20-24 is also respectfully requested.

The Examiner also rejected claims 25, 26, 29 and 30 under 35 U.S.C. § 102(b) as being anticipated by Jammet, et al. (EP 1072228). The Examiner stated that:

“claims 25, 26, 29 and 30 are being interpreted under 35 U.S.C. 112, sixth paragraph, means-plus-function language.”

The Examiner then stated under claim rejections 35 USC 102:

“Jammet et al. disclose a medical implant device comprising a first bone anchor, a second bone anchor, and *a brace comprising means for pivoting the brace from a first position to a second position (“any mechanical motion of surgeon moving around the component of the device before they are connected”)* wherein the second position of the brace couples the first bone anchor to the second bone anchor”.

If the claims are interpreted as means-plus-function language, then the rejection of claim 25 is improper, because the Examiner does not disclose the pivoting means. A means for pivoting the brace from a first position to a second position can not be interpreted as “any mechanical motion of surgeon moving around the component of the device before they are connected” because such an interpretation would claim a surgeon as part of the invention. As the Examiner is aware, according to 35 USC 101, a surgeon cannot be claimed. Also the Examiner does not state how the means for pivoting from a first position to a second position couples the first bone anchor to the second bone anchor.

Upon inspection of the US patent 6,626,904, it is further apparent that Jammet does not disclose other elements of claim 25. Specifically, Jammet fails to show a “means for transmitting torque between the brace and the at least one of the bone anchors.” The specification states “the ball 7 is provided with a bore 11 of a diameter corresponding to that of the *bearing* 4 on which it is also *freely* threaded.” (col. 3 third paragraph). The ball is further described as “a ball 7 *serving as a ball-bearing*, itself held in sandwich fashion between a lower cup 8 and an upper cup 9” (col. 3 second paragraph).

McGraw-Hill Dictionary of Scientific and Technical Terms (6th edition) defines a bearing as “A machine part that supports another part which rotates, slides or oscillates in or on it.” A ball bearing is further defined as “An antifriction bearing permitting free motion between moving and fixed parts by means of balls confined between outer and inner rings.” It is readily apparent from the cited definitions that bearings and ball bearings allow freedom of motion and thus not capable of applying torque. Accordingly, Jammet does not disclose all of the features in claim 25 and therefore cannot anticipate it. Withdrawal of the rejection claim 25 is respectfully requested.

Claims 26, 29 and 30 depend from claim 25 and recite further limitations in combination with the novel elements of claim 25. Therefore, the allowance of claims 25, 26, 29 and 30 is respectfully requested.

REMARKS

In view of the foregoing remarks, the Applicant believes that all of the claims currently pending in the Application are in a condition for allowance. The amendments do not introduce new matter or limit the scope of the coverage available under the doctrine of equivalents. The Applicant, therefore, respectfully requests that the Examiner withdraw all objection and rejections and issue a Notice of Allowance for all pending claims.

The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 06-2380, under Order No. 65677/P001US/10311263 from which the undersigned is authorized to draw.

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Respectfully submitted,

By


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